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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) JOHN BRYAN JONES and MICHAEL DICKMAN

TECH CENTER 1600/2900

Assignee: GENENCOR INTERNATIONAL, INC.

Title: CHEMICALLY MODIFIED MUTANT SERINE HYDROLASES SHOW IMPROVED CATALYTIC ACTIVITY AND CHIRAL SENSITIVITY

Serial No.: 09/436,513

Filing Date: November 9, 1999

Examiner: Charles Patterson

Art Unit: 1652

Docket No.: M-9066US

COMMISSIONER FOR PATENTS
Washington, D. C. 20231

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

In response to the Office Action dated August 17, 2000, Applicant respectfully requests reconsideration of the above-identified application in view of the following amendments and remarks. A petition to extend the period of response for two months is enclosed. For the convenience of the Examiner, a list of the pending claims is attached as Appendix I.

In the above-identified Office, the Examiner required restriction to one of the following groups under 35 U.S.C. §121:

- Group I: Claims 1-20 and 51-62, drawn to modified serine hydrolases and a method of making, classified in Class 435, subclass 221;
- Group II: Claims 21-30 and 43-50, drawn to a method of forming a peptide bond and incorporating an amino acid into a polypeptide, classified in Class 435, subclass 69.1;
- Group III: Claims 31-37, drawn to a method of resolving racemic alcohols, classified in Class 435, subclass 280; and
- Group IV: Claims 38-42, drawn to a method of attaching a chiral moiety to a substrate, classified in Class 435, subclass 135.

In response to this restriction requirement, Applicants provisionally elect Group I, claims 1-20 and 51-62 with traverse.

Applicants submit, however, that restriction between Groups I, II, III, and IV is unnecessary. According to MPEP §803, the Examiner should examine all claims in an application, **even though they are directed to distinct inventions**, unless to do so would create a **serious burden**. In the instant case, the claims of Group I are drawn to particular modified serine hydrolases. The claims of Group II are drawn to a method of forming a peptide bond using the modified serine hydrolase of Group I. Similarly the claims of Group III are drawn to a method of resolving racemic alcohols using the modified serine hydrolase of Group I, while the claims of Group IV are drawn to a method of attaching a chiral moiety to a substrate using the modified serine hydrolase of Group I. The claims of Group I are drawn to particular compounds, while the claims of the remaining groups are drawn to methods of use of these compounds. A search for prior art relevant to the compounds of Group I is also expected to identify prior art, if any exists, relevant to the methods of use of such compounds. Thus, a search for prior art relevant to all four Groups will entail no more effort than a search for prior art relevant to Group I alone. Consequently, there is no serious burden imposed by Examination of all four groups together. Accordingly, under MPEP §803, the restriction between Groups I, II, III, and IV should be withdrawn.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (415) 217-6021.

Respectfully submitted,



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